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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/575,991	04/13/2006	Lital Alfonta	54-000711US	2082

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EXAMINER	
GEBREYESUS, KAGNEW H	
ART UNIT	PAPER NUMBER
1656	

MAIL DATE	DELIVERY MODE
11/13/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/575,991	ALFONTA ET AL.	
	Examiner	Art Unit	
	KAGNEW H. GEBREYESUS	1656	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *23 June 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *31,34,35,39,41-44,46-49,51 and 54-61* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *31, 34, 35, 39, 41-44, 46, 47, 48, 49, 51, 54-61* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Applicant's response on June 23, 2009 to the Office Action dated May 06, 2009 is acknowledged. Applicants have added claims 59-61. Claims 31, 35, 43, 46, 47, 51, 56, 57 have been amended. Claims 50, 52 and 53 are canceled. Claims 31, 34, 35, 39, 41-44, 46 and 47-49, 51, 54-61 are present for examination.

Withdrawn - Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 46, 47-58 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. These rejections are withdrawn following the claim amendments.

Claim Objections

Claim 49 is objected to because of the following informalities: Claim 49 is identical to claim 48. Appropriate correction is required.

Maintained - Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

> the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 31, 34, 35, 39, 41-44, 46, 47, 48, 50-58 now including claims 59-61 were rejected under 35 U.S.C. 103(a) as being unpatentable over Schultz et al (US 7, 045,337 B2 / US 2003/0082575 A1 **in IDS**) in view of Rodriguez et al. for the reasons of record as set forth in the Office action mailed 10/28/2008.

Applicants argue:

".. Schultz is alleged to teach incorporating various unnatural amino acids into proteins of interest; incorporation of one or more unnatural amino acids; and redox unnatural amino acids. The Office notes that "Schultz et al do not specifically teach a protein composition comprising at least two or more different redox active amino acids including those" of the claims. Rodriguez binds a single DHP to the C-terminus of some proteins in a brain homogenate according to a mode of action not understood. Rodriguez is offered to "show that the redox active unnatural amino acid (DHP) can be incorporated into a protein in such a way as to exclude the incorporation of L-tyrosine." The allegations of the Office do not cure the defects of Schultz with regard to the previous claims, much less the currently amended claims. As a preliminary Matter, Applicants note that although claim 49 is nominally rejected in the Office Action Summary sheet, it is not actually rejected in the Action itself. Not all limitations of the amended claims have been alleged. Although it has been alleged that RSs may be provided with 90% identity to SEQ ID NO: 1, there is no allegation on the record regarding the limitations directed to the aspects of particular mutations at particular positions of the sequence...."

With regards to claim 49, Applicants are reminded that claim 49 is identical to claim 48. Thus any rejection that applies to claim 48 would necessarily apply to claim 49.

Applicant's argument with regards to the other claims has been considered carefully. The rejections with regard to instant claims 31, 34, 35, 39, 41-44, 46, 47, 48, 49, 51, 54-61 are withdrawn for the following reason.

The teachings in Schultz et al encompass a method of producing a genus of proteins comprising a genus of unnatural amino acids. Furthermore one would envisage a genus of proteins comprising unnatural amino acids from a genus of unnatural amino acids provided in Schultz et al's disclosure.

Withdrawn - Double Patenting

Claims 31, 46, 47, 48, 50-58 were rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1-6, 14 and 15 of U.S. Patent No. 7,045337. This rejection is withdrawn following the reasons of record cited above. However the following double patenting rejection will be applied.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 31, 34, 35, 39, 41-44, 46, 47, 48, 49, 51, 54-61 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 10-14, 40, 42 of U.S. Patent No. 7,494796 ('796 patent from hereon). Although the conflicting claims are not identical, they are not patentably distinct from each other because '796 patent teaches a cell comprising an O-tRNA, O-RS identical to the ORS in the instant application, the redox active amino acid 3, 4-dihydroxy-L-phenylalanine in an E. coli cell which further comprises a polynucleotide that encodes a polypeptide of interest (see for example claims 14 and 40 of '796 patent).

Conclusion:

No claims are allowed.

This is a non-final action because the double patenting rejection based on U.S. Patent No. 7,494796 was not made in the previous Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KAGNEW H. GEBREYESUS whose telephone number is (571)272-2937. The examiner can normally be reached on 8:30am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ANDREW WANG can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kagnew H Gebreyesus/
Examiner, Art Unit 1656